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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,142	03/11/2004	Akira Sugiyama	61,023 (48882)	7905

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05/03/2006

EXAMINER

GREENHUT, CHARLES N

ART UNIT PAPER NUMBER

3652

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/799,142	SUGIYAMA ET AL.	
	Examiner	Art Unit	
	Charles N. Greenhut	3652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **I. Drawings**

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the downstream stage pair, as recited in claim 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

## **II. Claim Objections**

1. Claim 1 is objected to because "raised said" in line 15 should read "raised, said"

2. Claim 1 is objected to because “by allowing a tip portion of each of said raised elevator pins to contact with or mate with” in line 19 should read “by a tip portion of each of said raised elevator pins contacting or mating with”
3. Claim 2 is objected to because “by allowing a tip portion of each of said raised elevator pins to contact with or mate with” in line 20 should read “by a tip portion of each of said raised elevator pins contacting or mating with”

### **III. Claim Rejections - 35 USC § 112**

The following is a quotation from the relevant paragraphs of 35 U.S.C. 112:

(1) The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2, 3, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how the substrate “will glide substantially under the force of its own weight...to the transport stage pair downstream” because the no force, other than gravity, is described to move the substrate. The force of gravity acts in a downward direction, not in the downstream direction.
2. Claims 2, 3, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A “transport stage pair which is immediately downstream of said selected

transport stage pair” is not supported by the specification. The embodiment, as best illustrated in Figure 15, does not describe a transport stage pair which is immediately downstream of said selected transport stage pair.

The following is a quotation from the relevant paragraphs of 35 U.S.C. 112:

(2) The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3.1. With respect to claim 3, the phrase “vibration-dampening material and/or cushioning material having rubber, resin, and/or gel-like silicone as a primary component” renders the claim indefinite because it is unclear what material or materials are included and what primary component or components could be present in the material or materials.

#### **IV. Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim(s) 4-5 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over AKAO (JP 11-347779 A) in view of OSTENDARP (US 6,220,056 B1).

1.1. With respect to claim 4, AKAO teaches a pair of transport stages (22)/(23), and rotating mechanism (24). AKAO fails to teach employing fluidic expulsion to float the workpiece and transferring from one stage to the other by reduction, termination or reversal. OSTENDARP teaches using fluidic expulsion to float the workpiece and transferring from one stage to the other by reduction, termination or reversal (Fig. 1-3). OSTENDARP also teaches the workpiece may be held in such a position via fluidic expulsion or suction for displacement to another position (Col. 3 Li. 1-2). It would have been obvious to one of ordinary skill in the art to modify AKAO with the fluidic expulsion and transferring mechanism of OSTENDARP in order to minimize the chance of contamination or damage to the workpiece.

1.2. With respect to claim 5/4, AKOA additionally teaches permitting horizontal and vertical movement.

#### **V. Allowable Subject Matter**

1. Claim 1 would be allowable if rewritten to overcome the objections set forth in this Office action.

1.1. With respect to claims 1 the following is a statement of reasons for the indication of allowable subject matter:

1.1(a) While the prior art teaches inverting devices having opposing plates and fluidic transport means, a workpiece transport apparatus having the structure described in the language of claim 1, that further includes the unique feature of an inverting means which uses elevator pins to contact the periphery of the substrate to retain

the substrate in floating fashion while inverting it, as recited in the language of claim 1, is not taught or fairly suggested by the prior art.

1.1(b) Claim 3 would be allowable if it were rewritten to depend solely from claim 1 and to overcome the 35 U.S.C. 112 rejections set forth in this office action.

1.1(c) Claim 5 would be allowable if it were rewritten to depend solely from claim 1.

#### **VI. Response to Applicant's Arguments**

Applicant's arguments entered 2/10/06 have been fully considered.

1. Applicant requests acknowledgement of his claim for foreign priority and acceptability of submitted drawings. Acknowledgement is made herewith on PTO form 326.
2. Applicant indicated PTO forms 892 and 1449 have not been received. These forms, however, were placed in the application file on 11/30/2005. Applicant may obtain additional copies of these form via the PAIR system.
3. Applicant argues that claim 1, as amended, defines over the art of record. This argument is persuasive. Examiner objected to informalities in the claim which were discussed via telephone interview on 4/26/06. An interview summary is attached hereto.

#### **VII. Conclusion**


1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
2. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end

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of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles N. Greenhut whose telephone number is (571) 272-1517. The examiner can normally be reached on 7:30am - 4:00pm EST.
4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen D. Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.
5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CG



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